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09/879,823	06/12/2001	Craig W. Barnett	INVE0010-4	6075

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EXAMINER
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ART UNIT	PAPER NUMBER
3622	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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	Application No.	Applicant(s)
Office Action Summary	09/879,823	BARNETT ET AL.
	Examiner	Art Unit
	Arthur Duran	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 April 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *64,69,71-74 and 77-112* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *64,69,71-74 and 77-112* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claims 64, 69, 71-74, 77-112 have been examined.

Response to Amendment

The Amendment filed on 4/30/10 is insufficient to overcome the rejection.

Examiner further notes that this office action is in after the February 8, 2006

decision by the Board of Patent Appeals and Interferences (BPAI) which affirmed

the Examiner in the rejection of the claims.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 4/30/10 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 98 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the enablement requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it

pertains, or with which it is most nearly connected, to make and/or use the invention.

The Specification discloses coupons and email. But, the Specification does not disclose coupons being sent to the user via email.

Claims 103, 108 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 103, 108 dated 4/30/10, disclose "wherein said unique identifier is associated with the online service address of said client personal computer".

The Examiner can find not support in the specification as disclosing the features of this claim. The citations make reference to printing the user social security number or the user online service address. However, the citations make no reference to indicia identifying of said client COMPUTER printed on the paper coupon.

The enablement must be consistent with the scope of the claims. Identifying the client computer can be interpreted to mean identification of the client's actual computer. This could be accomplished by the utilization of cookies or by recording a processor serial number or by recording a user device identification number.

The claims only have support for identifying the client's computer where this is interpreted to be the client's email or social security number or online service address. Hence, the Applicant's claims are broader than the specification and the claims are only supported in this narrower interpretation of the "client's computer".

And, importantly, the BPAI stated on 12/12/2005, in regards to related case

09/537,793, affirmed this similar 112 rejection as stated above. The BPAI on page 4

states:

"We will sustain the examiner's rejection of claims 47, 50, 52 and 53 for the

reasons argued by the examiner. We agree with the examiner that each of the forms of

identification discussed in appellants' specification identifies the user only and does not

identify the user's computer. The user ID barcode, as disclosed, contains information

which describes the user, not the user's computer. An online identification, such as an

email address, also identifies the user and not the computer. A user can change

computers and still receive email at the same address because the email address

describes the user and not the computer. Thus, appellants' specification does not

provide support for the recitation that the client computer is identified. Although most

computer users may only use a single computer so that the identification of the user is

tantamount to identifying the user's computer, the fact of the matter is that the types of

identification described in appellants' specification only identify the user of the computer

and do not uniquely identify the user's computer itself."

Hence, the "online service address" will be interpreted as online identification or

email address of the user.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 64, 69, 71-74, 77-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Hohorn (5,227,874) in view of Saigh (5,734,823).

Claims 103, 108: Von Kohorn discloses hosting at a server, wherein said server is configured to control components comprising a central coupon repository and a coupon redemption database (Figs. 1, 3, 28, 29, 31, 32; claim 27; 3:31-4:2);

transmitting between said server and a client personal computer using data communications interface means, including a network (Figs. 1, 3, 28, 29, 31, 32; claim 27; 3:31-4:2);

accessing said server by a potential consumer using said client personal computer (Figs. 1, 3, 28, 29, 31, 32; claim 27; 3:31-4:2);

transmitting a request to download coupons from said client personal computer to said server, wherein said request includes providing identification information from said potential consumer (claims 5, 6, 27), including demographic information from said potential consumer (claim 19, "shoppers' demographic and psychographic characteristics");

issuing a unique identifier by said server for said client personal computer, wherein said unique identifier is associated with the client computer (claims 5, 6, 27; 3:55-65; 109:10-16).

Von Kohorn discloses transmitting a coupon management routine from said server to said client personal computer, wherein said coupon management routine comprises said unique identifier; storing said coupon management routine in memory at

said client personal computer. Von Kohorn further discloses the coupon data

management software being used at least in connection with the printing of coupons

(col 109, lines 10-16). Also, Von Kohorn discloses enabling a user to download coupon

data management software to the at least one remote user computer system to be used

at least in connection with the printing of coupons. Von Kohorn discloses downloading

or transmitting instructional signals and programming routines (col 2, lines 55-60; col

109, lines 10-16; col 14, lines 20-25; col 20, lines 57-65; col 26, lines 45-52; col 6, line

56-col 7, line 27). Von Kohorn further discloses that the programming instructions are

ordered as a module or in a group (col 5, lines 31-45; col 4, line 21-35; col 41, liners 28-

60). Von Kohorn further discloses that the programmed response unit can print

incentives (col 2, lines 52-56; col 39, lines 24-31; col 41, lines 52-60; col 19, lines 29-34;

col 20, lines 57-64; col 22, lines 49-55; col 34, line 67-col 35, line 6). Also, Von Kohorn

discloses that the user's system is specified as a remote system (Fig. 2; page 20, lines

7-11). Furthermore, the printer's are associated with the user's system (page 16, lines

5-10). Also, Von Kohorn discloses that instructional signals can be transmitted for

managing or adjusting coupons:"(85)   The latter method has the advantage that a

sponsor or advertiser can have up-to-date promotional information printed on coupons

by directing the station which transmits instructional signals to remote locations to

include in such signals the desired advertising material. A last-minute-telephone call by

an advertiser to the sub-carrier station with directives to incorporate certain instructional

signals in the sub-carrier transmission will result in a large number of shoppers being

alerted to special sales through up-to-the-minute coupon promotions" (col 19, lines 29-

39). Hence, Von Kohorn discloses downloading or transmitting instructional signals and

programming routines where the programming instructions can be ordered as a module

or in a group that is utilized for coupon adjusting, coupon managing, coupon printing

which is functionally equivalent to downloading to the one or more remote user systems

an incentive data management software module. Von Kohorn further discloses

providing a unique identifier to the client personal computer (3:55-65; 37:15-20, "By way

of example, the validation signal may be encoded with the time of day and date of the

television program and be combined with <u>a number identifying the remote station or

user</u>"). Saigh further discloses unique user id downloaded to the computer and used to

uniquely mark data downloaded to the computer (9:65-10:5; 15:35-50; claim 10).

Von Kohorn discloses transmitting a request for coupons from said client

personal computer to said server, wherein said request comprises including an encoded

version of said unique identifier (claims 5, 6, 27; 10:40-45).

receiving said request for coupons at said server (claims 5, 6, 27);

decrypting said encrypted version of said unique data at said server (10:40-45;

15:25-31; 22:14-20);

verifying said unique identifier at said server to confirm that said potential

consumer is a valid user (claims 5, 6, 27);

transmitting coupons from said server to said client personal computer (claims 5,

6, 27); and

storing said coupons in memory at said client personal computer (decrypting said

encrypted version of said unique identifier at said server), wherein said memory

comprises an output buffer residing in random access memory (Fig. 5, item 114, "buffer

store") Saigh further disclsoes buffer memory that can be used for coupons (8:55-65).

Also, the Microsoft Press Computer Dictionary Third Edition defines 'personal

computer' as, "A computer designed for use by one person at a time. Personal

computers do not need to share the processing, disk, and printer resources of another

computer." Von Kohorn discloses the utilization of a personal computer by the potential

customer (Fig. 26; col 75, lines 31-49; col 76. lines 20-33; col 14, lines 20-25).

Von Kohorn further discloses downloading coupon information from a host to a

client (col 74, lines 33-55; Fig. 29; col 2, lines 45-57; col 5, lines 56-61; col 22, lines 1-

11) where the host is a host computer (col 94, lines 32-47) and the client is a client

computer (Fig. 26).

Von Kohorn further discloses that the consumer can indicate an interest in a

product and (col 47, line 40-col 48, line 2) and incentives can be coupons (col 2, lines

45-52).

Von Kohorn does not explicitly disclose utilizing the Internet. Von Kohorn further

discloses that the method can utilize a variety of networks (col 44, line 45-col 45, line

15; col 88, line 55- col 89, line 15). And, Saigh further discloses hosting an Intemet

website at a server, wherein said server is configured to control components comprising

a central coupon repository and a coupon redemption database; transmitting between

said Internet website and a client personal computer using data communications

interface means, including the Internet (Fig. 11; 14:15-15:10; 2:12-35; 8:55-65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to add Saigh's utilization of the Internet to Von Kohorn transmitting coupons. One would have been motivated to do this because the Internet is a readily available network for transmitting information.

Von Kohorn does not explicitly disclose wherein said unique identifier is associated with the online service address of said client computer. Please see the 112 rejection above. Von Kohorn does not explicitly disclose an online service provider or an online service address. As noted above, Von Kohorn discloses wherein said client personal computer is associated with said potential consumer based upon an identifier of said client personal computer; wherein said identifying indicia includes said identifier of said client personal computer; and printing the unique identifier on the coupon.

Von Kohorn does not explicitly disclose that the unique identifier is online service address. Examiner notes that Applicant's "online service address" is minimally defined (page 16:20-17:5 of Applicant's Specification):

"In addition to the usual coupon information found in prior art coupons (e.g. redemption amount, company and product name, expiration date, etc.), the coupons 18 of the preferred embodiment of the present invention contain user-specific data in the form of a unique user bar code 90, as shown graphically in FIG. 5. The user bar code 90 is encoded with user-specific information such as the user name and/or other unique identification criteria such as a social security number or <u>online service address</u>. This information renders each printed coupon 18 unique, since an otherwise similar coupon presented by a different consumer will comprise a different user bar code 90."

This is the only occurrence of online service address. The Specification does mention email Internet address (Page 32:20-25): "In this embodiment, the downloaded coupon management routines are encoded with a unique user identification number, which may be for example the user's <u>email</u> Internet <u>address</u>."

And, very importantly, the BPAI stated on 12/12/2005 on page 4, in regards to related case 09/537,793:

"<u>We will sustain the examiner's rejection</u> of claims 47, 50, 52 and 53 for the reasons argued by the examiner. We agree with the examiner that each of the forms of identification discussed in appellants' specification identifies the user only and does not identify the user's computer. The user ID barcode, as disclosed, contains information which describes the user, not the user's computer. An online identification, such as an email address, also identifies the user and not the computer. A user can change computers and still receive email at the same address because the email address describes the user and not the computer. Thus, appellants' specification does not provide support for the recitation that the client computer is identified. Although most computer users may only use a single computer so that the identification of the user is tantamount to identifying the user's computer, the fact of the matter is that the types of identification described in appellants' specification only identify the user of the computer and do not uniquely identify the user's computer itself."

Hence, the "online service address" will be interpreted as online identification or email address of the user.

Saigh further discloses unique user id downloaded to the computer and used to uniquely mark data downloaded to the computer (9:65-10:5; 15:35-50). And, Saigh discloses identifying users by e-mail when users correspond concerning coupons and promotions (14:25-30, "Users may even shop electronically by manipulating the promotional and commercial information and placing orders through E-Mail from a personal reader/computer or by ordering directly from an interactive promotional Book Bank). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Saigh's identifying users via e-mail address to Von Kohorn's printing user identifiers on coupons. One would have been motivated to do this in order to better provide a way of identifying users on coupons. As a further example of how this is obvious, MPEP 2144.06.II states that substituting equivalents known for the same purpose is obvious. The user identifiers in Von Kohorn and e-mail identifier in Saigh are both user identifiers. Hence, it is obvious that the e-mail identifier in Saigh can be substituted for the identifier in Von Kohorn (MPEP 2144.06.II).

Von Kohorn does not explicitly disclose wherein said coupon management routine includes an offline coupon management routine file. However, Saigh discloses wherein said coupon management routine includes an offline coupon management routine file (claims 16, 17; Fig. 12, "Reader" device). Hence, it would be obvious that Von Kohorn can manipulate the coupons stored locally when not connected to the central station. One would be motivated to do this to better allow users to work even if a connection is not present.

Von Kohorn does not explicitly disclose wherein said request comprises including
an encrypted version of said unique identifier, or decrypting said encrypted version of
said unique identifier at said server.

However, Von Kohom discloses the utilization of encryption related to identifying
indicia (col 10, lines 40-45) and Von Kohorn discloses encoding and decoding (Fig. 7,
'Coder'; Fig. 8, 'Decoder').

Von Kohorn further discloses the user transmitting the unique user identifier and
also that the user identifier can be a code (col 61, lines 34-55; col 105, lines 51-65;
claims 5, 6). Von Kohorn further discloses that codes, encoding, and encryption are
related (col 10, lines 40-45).

And, Saigh further discloses utilizing encryption or encoding (col 15, lines 10-16;
claim 10; col 15, line 10-col 17, line 32). Also, Saigh in Figure 12 discloses utilizing the
User's ID and Serial Number in 2nd Level Encryption procedures. And, Saigh Figure 8
discloses that a customer enters a site and that a user id and pin or password are
entered and transmitted to a central site (Figure 8). And, Saigh discloses reading an
encrypted user id and password (Saigh, claim 10). Saigh further discloses transmitting
an encoded user id to a central site (col 9, lines 33-64 and col 10, line 40-col 11, line 19;
col 9, lines 50-60). And, Saigh further discloses using common encryption procedures
for encrypting data transmitted (Saigh, 15:58-16:10, "well known encryption
algorithms... The DCP contains the structure to encrypt and decrypt data using National
Bureau of Standards encryption algorithms.").

And, Saigh discloses a variety of encryption techniques and that a variety of

information that is communicated or transmitted can be encrypted (col 15, line 35-col

17, line 33; col 15, lines 37-47; col 15, line 59-col 16, line 10; col 17, line 20-33)

Therefore, it would have been obvious to one having ordinary skill in the art at

the time the invention was made that Von Kohorn transmitting of unique user identifiers

in the form of codes can also be in the form of encryption. One would have been

motivated to do this in order to better secure the communications of the unique identifier

of the user.

Alternatively, Von Kohorn discloses encoding and decoding (Fig. 7, 'Coder'; Fig.

8, 'Decoder'). Von Kohorn discloses the central station encoding and the response unit

(user unit) decoding. And, as noted above, Von Kohorn discloses that encoding, and

encryption are related (col 10, lines 40-45). And, the MPEP 2144.04 VI discloses that

reversal or duplication is an obvious modification. Hence, reversing Von Kohorn so that

the user unit encodes and the central station decodes is an obvious modification. Or,

duplicating the encoder of the central station into the user unit and duplicating the

decoder of the user unit into the central station is an obvious modification. And, in

regards to Saigh, it is obvious that the encryption of transmission that occur from the

central site to the user site can also occur for transmissions from the user site to the

central site. Hence, transmitting the unique user identifiers in encrypted form is an

obvious form of reversal or duplication.

Also, It is the combination of Von Kohorn and Saigh or, alternatively, the

combination of Von Kohorn and Saigh and Crawford (below) that renders encryption of

transmitted identifier obvious. As noted above, Von Kohorn discloses transmitting

identifier. Von Kohorn discloses encryption and decrypting (10:40-45; 15:25-31; 22:14-

20). And, Saigh discloses that a wide variety of information can be encrypted prior to

transmission. Please see the citations above. Also, Crawford particularly shows

encrypting the identifier (see below).

Also, Saigh further discloses a central database (Fig. 11) and e-commerce

including further features related to downloading and using coupons (14:15-15:10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to add Saigh's further coupon features to Von Kohorn's coupon

downloading. One would have been motivated to do this in order to better offer

coupons.

Claim 64: The prior discloses the method of claim 63, wherein the stored coupon

information is stored in a repository at the internet-accessible location (Von Kohorn,

claims 28, 29; Fig. 7; Saigh, 14:15-15:10; Fig. 11).

Claim 69. The prior art further wherein storing information pertaining to a group of

available coupons further comprises storing advertising materials provided by one or

more coupon issuers or coupon distributors (Von Kohorn, Fig. 33; Saigh 14:15-15:10).

Claim 71. The prior discloses the method of claim 69, wherein displaying coupon

information further comprises displaying the advertising materials (Von Kohorn Fig. 33,

item 1007).

Claim 72. The prior discloses the method of claim 63, wherein registration associates the user with an account (Von Kohorn, claim 5, 6; 3:57-65; 37:15-20; 106:15-23).

Claim 73. The prior discloses the method of claim 72, wherein a household of users may be linked through the account (Von Kohorn, 3:57-65).

Claim 74. The prior discloses the method of claim 72, wherein a household of users may be linked through one account (Von Kohorn, 3:57-65).

Claim 77: The prior art discloses wherein fixed coupon format data is downloaded with the coupon data management software (Von Kohorn, claim 27; 37:15-20; 3:57-65; 3:31-37; claim 5, 6). Note that the user id is downloaded to the client device and that the user id is printed on the coupon and that the user id functions as fixed coupon data (see Applicant's Fig 3 of Applicant's Specification.).

Claim 78: . The prior art discloses wherein fixed coupon format data is downloaded with the coupon data management software, and is used to format data downloaded to the computer when a user requests a coupon to be printed (Von Kohorn, claim 27; 37:15-20; 3:57-65; 3:31-37; claim 5, 6). Note that the user id is downloaded to the client device and that the user id is printed on the coupon and that the user id functions as fixed coupon data (see Applicant's Fig 3 of Applicant's Specification.).

Claim 79. The prior discloses the method of claim 63, wherein the displayed coupon information includes a product for which a coupon is available, and a discount for that product (Von Kohorn Fig. 33).

Claim 80. The prior discloses the method of claim 63, wherein a coupon has a

redemption discount amount associated with a product, and the redemption discount

amount for a user depends on certain demographic information associated with the user

(Von Kohorn 102:65-70; 102:30-109:2; Fig. 33).

Claim 81. The prior discloses the method of claim 63, wherein the coupons

available to a user are based on at least selection history information for the user (Von

Kohorn 106:4-10; 102:30-109:2).

Claim 82: Von Kohorn does not explicitly disclose wherein the wherein the

coupons available to a user are sorted by categories. However, Von Kohorhn discloses

coupons and shopping lists (Von Kohorn Fig. 33, 34). Von Kohorn further discloses the

user picking mutltiple coupons (Von Kohorn claim 27;102:30-109:5). And, Saigh

discloses coupons and catalogs (Saigh 14:15-15:10). Therefore, it would have been

obvious to one having ordinary skill in the art at the time the invention was made that

Von Kohorn's multiple coupons selected can be organized into different categories

similar to how a catalog can be organized. One would have been motivated to do this in

order to better allow selection of coupons.

Claim 83. The prior discloses the method of claim 63, further comprising

providing a user with a shopping list relating to at least one selected coupon (Von

Kohorn Fig. 33, the printout includes the related product information for the coupon

selected).

Claim 84. The prior discloses the method of claim 83, wherein the shopping list is

printed along with the at least one selected coupon (Von Kohorn Fig. 33; 3:31-37).

Claim 85. The prior discloses the method of claim 83, wherein the shopping list is printed separate from the at least one selected coupon (Von Kohorn Fig. 34).

Claim 86: The prior art discloses the above. Von Kohorn does not explicitly disclose wherein printing further comprises printing a unique bar code on the coupon.

However, Von Kohorn discloses uniquely identifying the coupon (2:20-25; 3:31-37). And, Von Kohorn discloses utilizing bar codes for identifying particular tickets (98:25-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Von Kohorn can use bar codes to identify coupons. One would have been motivated to do this in order to better identify coupons.

Claim 87. The prior discloses the method of claim 86, wherein the bar code includes a unique identifier (Von Kohorn claim 27).

Claim 88. The prior discloses the method of claim 63, wherein each coupon printed is unique (Von Kohorn claim 27).

Claim 89. The prior discloses the method of claim 63, wherein each coupon printed is printed with a unique bar code (see claim 86 preceding) including unique identification information (Von Kohorn claim 27).

Claim 90. The prior discloses the method of claim 63, wherein each coupon printed is printed with a unique information number (Von Kohorn claim 27; 37:15-20).

Claim 91. The prior discloses the method of claim 63, wherein each coupon printed is printed with a unique bar code (see claim 86 preceding) including unique identification information based on information stored on the computer (Von Kohorn claim 27; 37:15-20).

Claim 92. The prior discloses the method of claim 63, wherein each coupon printed is printed with user- specific information (Von Kohorn, Fig. 33).

Claim 93: Von Kohorn does not explicitly disclose setting a flag to render a coupon unprintable after it has been printed to protect against fraud. However, Von Kohorn discloses unique coupons (claim 27; 37:15-20). And, Saigh discloses printing limits to prevent fraud or theft (6:47-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the features of the two inventions since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 94. The prior discloses the method of claim 63, further comprising: receiving redemption information regarding one or more printed coupons that have been redeemed; and storing the redemption information at the internet-accessible location (Von Kohorn Fig. 33; 102:30-109:2).

Claim 95. The prior discloses the method of claim 94, wherein the redemption information is associated with a user associated with the computer (Von Kohorn, 3:57-65).

Claim 96. The prior discloses the method of claim 94, wherein the redemption information is associated with an account associated with the computer (Von Kohorn, 3:57-65).

Claim 97. The prior discloses the method of claim 63, further comprising:

receiving redemption information and using the received redemption information to

generate at least one subsequent coupon targeted specifically at the user (Von Kohorn ,

106:5-10).

Claim 98: Von Kohorn does not explicitly disclose wherein the at least one

subsequent coupon is provided to the user via an electronic mail message. However,

Von Kohorn discloses electronic coupon distribution (see citations above). And, Saigh

discloses email and coupons and shopping (14:25-31). Therefore, it would have been

obvious to one having ordinary skill in the art at the time the invention was made that

Von Kohorn's electronically distributed coupons can be distributed via email. One

would have been motivated to do this in order to better provide a coupon distribution

method of convenience to the user.

Claim 99. The prior discloses the method of claim 97, wherein the at least one

subsequent coupon is downloaded from the Internet accessible location (Von Kohorn,

claim 27).

Claim 100. The prior discloses the method of claim 97, wherein the at leastone

subsequent coupon is provided to the user at a regular interval (Von Kohorn, 103:13-

16).

Claim 101. The prior discloses the method of claim 97, wherein the at least one

subsequent coupon is for a product other than a product covered by a redeemed printed

coupon (Von Kohorn, 102:40-103:45).

Claim 102. The prior discloses the method of claim 97, wherein the at least one subsequent coupon is for a same product covered by a redeemed printed coupon, but has a different monetary value (Von Kohorn, 102:65-70).

Claim 104, 109. Von Kohorn further discloses the method of claim 103, further comprising: modifying, by said server, the value of said coupon after said potential consumer downloads a coupon (80:20-35; 83:10-35).

Claim 105, 110. Von Kohorn further discloses the method of claim 103, further comprising: updating, by said server, the coupon data stored in said client personal computer, without required interaction from said potential consumer, if said potential consumer in online (80:20-35; 83:10-35).

Claim 106, 111. Saigh further discloses the method of claim 103, further comprising: transmitting printable coupon data from said output buffer to a retailer for electronic coupon redemption (2:14-34; 8:55-65, "buffer memory"; 14:15-31, "shop electronically by manipulating the promotional and commercial information and placing orders"; Fig. 6, "buffer").

Claim 107, 112. Von Kohorn further discloses the method of claim 103, further comprising: transmitting a file containing user-specific data associated with coupons redeemed by said potential consumer from a retailer to said coupon redemption database, wherein said coupon redemption database transmits said file to said central coupon repository; analyzing (1) said file, (2) information regarding all coupons available by coupon issuers, (3) information regarding all coupons selected by said potential consumer, (4) information regarding all coupons printed by said potential consumer, and

(5) demographic information regarding said user, by said central coupon repository in

order to compile a subsequent coupon package for said potential consumer; and

transmitting said subsequent coupon package from said server to said potential

consumer (claim 27; 3:33-4:2).

Claims 64, 69, 71-74, 77-112 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Von Hohorn (5,227,874) in view of Saigh (5,734,823) in view of

[Crawford (6,411,943) OR Crawford (7,080,051)].

Please see the rejections stated above.

And, note the addition of the Crawford reference to the rejection stated above.

Von Kohorn does not explicitly disclose encrypting the transmitted unique user

identifier.

However, Crawford (6,411,943) discloses encrypting the transmitted unique user

identifier (claim 14).

Alternatively Crawford (7,080,051) discloses encrypting the transmitted unique

user identifier (Claim 1; also, see claim 3 preamble; and, claims 3, 10, 13-17 and 20-

22).

Therefore, it would have been obvious to one having ordinary skill in the art at

the time the invention was made that Von Kohorn's transmitted unqiue identifier can be

encrypted. One would have been motivated to do this in order to better secure the

validity of the unique identifier of the user.

Dependent claims: Please see the rejection of the dependent claims above.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are not found persuasive. Please see rejection above.

Examiner further notes that this office action is in after the February 8, 2006 decision by the Board of Patent Appeals and Interferences (BPAI) which affirmed the Examiner in the rejection of the claims.

Also, on 4/30/10, Applicant entered new independent claims 103 and 108. These new claims are rejected above. Also, Applicant entered new dependent claims 104-107 and 109-112. These new dependent claims are rejected above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Arthur Duran/
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5/13/2010